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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,583	08/16/2001	Paul W. Reece	36-1474	2915
23117	7590	04/13/2006	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			NGO, NGUYEN HOANG	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 04/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/913,583

Applicant(s)

REECE, PAUL W.

Examiner

Nguyen Ngo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

This communication is in response to the RCE of 2/ 24/2006. All changes made to the Title, and Claims have been entered. Accordingly, Claims 1-5 and 9 are currently pending in the application.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

**Regarding claim 1 and 9**, with regards to the newly added limitation of having "a first router change its operating protocol only when and if a user elects to initiate the use of a switched virtual circuit," is not disclosed in the Specification. The Examiner notes the referral to an ATM access router (page 3 lines 30-31) but fails to see the limitation of having the router switch protocols disclosed in the Specification. Furthermore, figures 2-7 does not teach of such a router and it is understood that figures 1 shows a router, but it is not apparent that this router (7 of figure 1) is capable of switching between

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protocols, as the switching of protocols may be implemented in the client terminal as seen by the arrows (1 of figure 7). The router may interface both the IP and ATM network, and the switching of protocols may be done in the client terminal. It should be clearly shown in the Specification of such a limitation. The same reasoning may also be applied to claim 9.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-5 and 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Civanlar et al. (U.S 5,995,606), in view of Bhatia et al. (US 6563824), hereinafter referred to as Civanlar and Bhatia.

**Regarding claim 1**, Civanlar discloses a method of operating a client-server network, which enables the establishing of a connection over the Internet between a client and a

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server (a method of operating a communications network and terminal connected thereto (client and server terminals), col2 lines 41-45). Civanlar further discloses;

establishing a connection between the client and the server over the internet (establishing a data flow (connection) between a customer terminal (client) and another data terminal (server), the data flow conforming to a best-effort packet-routing protocol (Internet), col4 lines 53-55 and 301 and 302 of figure 3) and that the client apparatus have a single physical connection or modem (first router) that is used to attach (via a protocol) to both the Internet and the public switch network (via a first router operating in accordance with a best effort packet routing protocol (modem interface to IP network), col3 lines 10-15).

of a client apparatus which makes a service request that requires a service functionality of a switched network connection (subsequently initiating from the customer terminal (client) the use of a switched virtual circuit (switched network), col4 lines 55-57 and 303-308 of figure 3) and establishing a connection for exchange of data over the switched network (col5 lines 44-48) through the modem of the client apparatus which interfaces the public switch network (via the first router operating in accordance with a switched virtual circuit protocol (modem interface to switched network, col3 lines 10-15).

That only when a user at a client apparatus connects to a server through the Internet and requests service that requires enhanced functionalities offered by the switched network does a connection through the switched network is established

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(wherein only when and if the user elects to initiate the use of a switched virtual circuit, col3 lines 20-25).

Civanlar however fails to specifically disclose of a router changing its operating protocol. However Civanlar discloses, as stated above, of the client apparatus having a single physical connection or modem (correlating to router) that is attached to both the Internet and public switched network, which provides the motivation of having a router located internally inside a modem to switch protocols dependent on the type of connection between the server and the client in order to correctly and efficiently send data through the connection.

Bhatia further discloses that modems contain routers and that modems can operate as a true router that connects workstations (clients) to different remote networks (first router (modem) capable of changing its operating protocol (dependent on a connection to a specified network), col4 lines 4-7 and col4 lines 20-40).

It should thus be obvious to a person skilled in the art to incorporate the use of a router inside a modem or having a modem act as a router as disclosed by Bhatia into the method of operating a client-server network, which enables the establishing of a connection over the Internet or the Public Switch Network between a client and a server as disclosed by Civanlar in order to correctly and efficiently send data through a connection conforming to the correct protocol.

**Regarding claim 2**, with respects to the limitation of communicating to the customer terminal data indicating the availability of a switched virtual circuit in the network for the said data flow prior to step b of claim 1. Civanlar discloses that prior to the public switch connection, which the Examiner interprets as use of a switched virtual circuit, for such service requests, the server may initiate a call connection over the public switched network, and deliver information for the requested service (col3 lines 31-35). Civanlar however is silent as to, specifically indicating the availability of the connection. To include such "indication of availability" in the delivery of information for the requested service would have been obvious to one of ordinary skill as it is well-known and recognized in the art to include the "indication of availability" in such information.

**Regarding claim 3**, with respects to the limitation of the said data indicating availability of a switched virtual circuit comprises a URL having the format specific to resources located on a circuit-connected network. Civanlar discloses that the access by a client apparatus to a server via the Internet utilizes the Hyper Text Transport Protocol (HTTP), which is accessed using a Mosaic application program available at the client apparatus (col4 lines 38-42). Civanlar however is silent as to indicating the availability of a switched virtual circuit comprising a URL. However it is clearly known that the URLs have the basic from: "protocol://server/request-URI". That the protocol part describes how to tell the server, which document the one may want and how to retrieve it. The server part tells the browser which server to contact, and the request-URI is the name

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used by the server to identify the data. The HTTP protocol is based on a request/response paradigm. It would have thus been obvious to a person skilled in the art to provide the information, including the "indication of availability" as mentioned above in claim 2, as data comprising a URL since Civanlar discloses the utilization of HTTP.

**Regarding claim 4**, as already mentioned, discloses the best-effort packet routing protocol be the Internet (col2 line 34 and 150 of figure 1).

**Regarding claim 5**, as already mentioned, discloses that the public switched network can be an ATM network (col2 line39).

**Regarding claim 9**, the combination of Civanlar and Bhatia discloses all the limitation of claim 9 as discussed in claim 1. Same rationale applied to claim 1, may be applied to claim 9, as the combination of Civanlar and Bhatia discloses a first router (modem correlating to router, col3 lines 10-14) operable to route data packets in a data flow between a customer terminal (client of figure 1) and another terminal (server) in accordance with a best-effort packet routing protocol (internet network of figure 1); the first router being further operable to switch the data of the data flow in accordance with a switched virtual circuit protocol (public switched network connection), but only in response to the customer terminal initiating a switched virtual circuit for data flow



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(service request that requires a service functionality of a switched network connection, col3 lines 20-25).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nguyen Ngo whose telephone number is (571) 272-8398. The examiner can normally be reached on Monday-Friday 7am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on (571) 272-3139. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NN  
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**Nguyen Ngo**

United States Patent & Trademark Office  
Patent Examiner AU 2663  
(571) 272-8398

  
**Ajit Patel**  
**Primary Examiner**